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| 10/649,714 | 08/25/2003 | Gerardo Orozco Abundis | 200205562-1 | 6169 |

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| EXAMINER |
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POON, HOA K

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| ART UNIT | PAPER NUMBER |
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04/03/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/649,714 | Applicant(s) ABUNDIS ET AL. | |
| | Examiner HOA POON | Art Unit 4157 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 25 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10, 11, 13-17, 19 and 21 is/are rejected.
- 7) ☒ Claim(s) 9, 12, 18, 20, 22 and 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>March 21, 2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 , 7 and 16 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term “shifter” is vague based on how it is claimed. The shifter is disclosed nothing more but just a fixed lens with a fixed refractive index. It is unclear how the focal is shifted within a same lens as claimed provided the lens is moved or interchangeable with different lens with different refractive index. For the purpose of prior art consideration, focal shifter will be construed as a lens having a fixed focal point.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 4157

The factual inquiries set forth in **Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966)**, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows: (*See MPEP Ch. 2141*)

- a. Determining the scope and contents of the prior art;
- b. Ascertaining the differences between the prior art and the claims in issue;
- c. Resolving the level of ordinary skill in the pertinent art; and
- d. Evaluating evidence of secondary considerations for indicating obviousness or nonobviousness.

2. Claim (1-8), 10, (13-17) and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai (Patent No. 6,637,897) in view of Rich (Patent No. 5,359,386)

Regarding claim 1, 7 and 16: Tsai teaches a method of scanning a media:

A method for scanning media comprising (See Tsai, fig. 5A, 5B and 5C and Abstract);

However, Tsai fails to disclose a lens that interposed between a scanner surface and a target surface.

Rich discloses:

positioning a medium having a target surface proximate to a surface of a scanner (See Rich, Abstract, line 1-4); and

providing a focal point shifter (See Rich, Abstract, line 5-7) interposed between said surface of said scanner and said target surface.

Art Unit: 4157

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Tsai and Rich to provide a well known method where the lens is placed at a position between the object and image plane. The total distance from the object to the image is a direct function of the lens focal length and the magnification factor (See Rich, col. 1, line 29-32).

Regarding claim 2, 8 and 17: Tsai does not disclose the method further comprising refractively shifting a focal point of the scanner from a point proximate to said scanner from a point proximate to said scanner surface to a point proximate to said target surface. However, Rich discloses:

The method of claim 1 further comprising:

refractively shifting a focal point of the scanner from a point proximate to said scanner from a point proximate to said scanner surface to a point proximate to said target surface (See Rich, col. 5, line 10-15).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Tsai and Rich to provide a method that refractively shifting a focal point of the scanner from a point proximate to said scanner from a point proximate to said scanner surface to a point proximate to said target surface.

Regarding claim 3, 10 and 19: Tsai does not disclose the method that further comprising pressing said target surface toward a first surface of said shifter.

However, Rich discloses:

Art Unit: 4157

The method of claim 1 further comprising: pressing said target surface toward a first surface of said shifter (See Rich, col. 2, line 61-65, photosensitive material is supported in substantially parallel relation with the negative shuttle corresponds to pressing said target surface toward a first surface of said shifter). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Tsai and Rich to provide a method that comprises pressing said target surface toward a first surface of said shifter.

Regarding claim 4 :

Claim 4 is rejected based on the same reasoning as claim 1 which focal shifter is construed as a lens.

Regarding claim 5, 13 and 22: Tsai does not disclose the method that maintaining a separation between said shifter and said surface of said scanner to minimize interference effects. However, Rich discloses:

The method of claim 1 further comprising: maintaining a separation between said shifter and said surface of said scanner to minimize interference effects (See Rich, fig. 5A, where element 4 is the scanning target, once it is placed into the concave opening 301, the thickness of the device 30 will prohibit the bottom surface of the scanning target to be separated with the said scanner surface).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Tsai and Rich to provide a method that maintaining a separation between said shifter and said surface of said scanner to minimize interference effects.

Art Unit: 4157

Regarding claim 6, 14 and 23: Tsai does not disclose the method that maintaining a separation between said shifter and target surface to minimize interference effects. However, Rich discloses:

The method of claim 1 further comprising: maintaining a separation between said shifter and said target surface to minimize interference effects (See Rich, fig. 5A, where element 4 is the scanning target, once it is placed into the concave opening 301, the second opening 303 will keep the top surface of the scanning target to be separated with any object is placed on top of it).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Tsai and Rich to provide a method that maintaining a separation between said shifter and target surface to minimize interference effects.

Regarding claim 7:

Claim 7 contains limitations corresponding to claim 1; therefore, it is analyzed and rejected as claim 1.

Allowable Subject Matter

3. Claims (9, 18), (12, 20) and (22, 23) are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitation of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Art Unit: 4157

Regarding claims 9 and 18: the prior art of record fails to anticipate or render obvious the following limitations as claimed:

“...wherein said shifting means is incorporated in a template”.

Regarding claims 11 and 21: the prior art of record fails to anticipate or render obvious the following limitations as claimed:

“wherein said shifting means is shaped to be slideably insertable into a media holder bringing the target surface closer to said shifting means”.

Regarding claims 12 and 20: the prior art of record fails to anticipate or render obvious the following limitations as claimed:

“wherein said shifting means is shaped to conform with said target surface”.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HOA POON whose telephone number is (571)270-3758. The examiner can normally be reached on 8:30 am - 5:00 pm M-F EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vu Le can be reached on (571) 272-7332. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 4157

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hoa Poon/
Examiner, Art Unit 4157

/Vu Le/
Supervisory Patent Examiner, Art Unit 4157